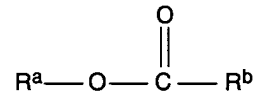
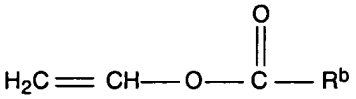
extend beyond the expiration date of ***US 6,579,953***, and agreeing that a patent granted on this application shall be enforceable only for and during such period that the legal title of the patent is the same as the legal title to ***US 6,579,953***. Withdrawal of the provisional rejection under the judicially created doctrine of obviousness-type double patenting based on Claims 1 to 6 of ***US 6,579,953*** is therefore respectfully solicited.

The Examiner maintained the rejection of Claims 1 to 25 and 32 under 35 U.S.C. §102(a) as being anticipated by the teaching of ***Blankenburg et al.*** (**WO 99/04750** *which is an equivalent of* **US 6,403,074**). The Examiner found applicants' argument that ***Blankenburg et al.***'s formula reads on acrylic acids whereas applicants' claims require the vinyl esters of C_1-C_{24}-carboxylic acids not to be persuasive. More particularly, the Examiner pointed out that the double bond in ***Blankenburg et al.***'s formula was *"**not** in the acid part of the ester but between two carbon atoms"*.

For clarification it is respectfully submitted that vinyl esters of carboxylic acids and esters of acrylic acids are "ethylenically unsaturated" compounds which means that the double bond is, in each case, located between two carbon atoms. The distinction between the "alcohol part" and the "acid part" of the esters does not imply otherwise. Every carboxylic acid ester is represented by the following generic formula

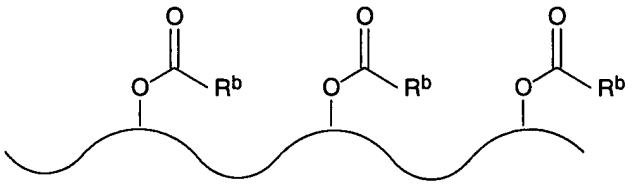


which is an alternative format to the representation R^a-O-C(O)-R^b. The moiety "R^a-O-" of the generic formula is generally designated as the "alcohol part" because it is introduced into the ester through the alcohol. Correspondingly, the moiety "O-C(O)-R^b" is generally understood as the "acid part" of the ester because it is introduced through the carboxylic acid. In a vinyl ester of a carboxylic acid as referenced in applicants' claims comprise, in the position of R^a of the above formula a H_2C=CH-group and can, therefore, be represented as

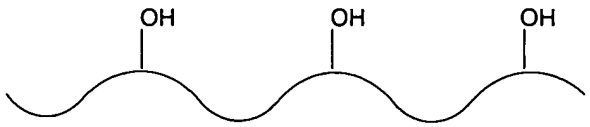


or as H_2C=CH-O-C(O)-R^b. When vinyl esters of such type are polymerized the vinyl groups form a -C-C-C-C- polymer chain which carries -O-

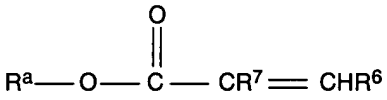
C(O)-R^b substituents, as illustrated schematically in the following representation:



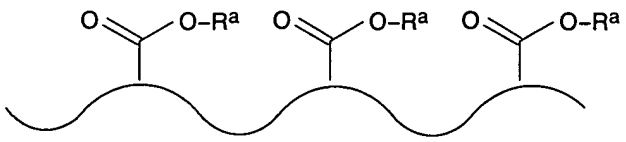
Hydrolysis of such units cleaves the ester bond so that a -C-C-C-C- polymer chain is formed which carries hydroxyl groups, for example:



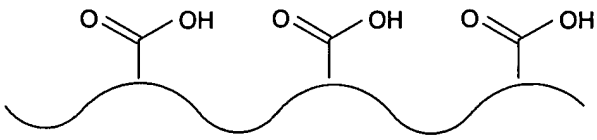
The ethylenically unsaturated monomers of ***Blankenburg et al.*** are represented by the formula X-C(O)-CR^7=CHR^8, wherein X is inter alia R^8-O-, corresponding to the following esters:



When esters of the type illustrated by ***Blankenburg et al.***'s formula are polymerized the -CR^7=CHR^6 groups form a -CR^7-CR^6-CR^7-CR^6- polymer chain which carries C(O)-O-R^a substituents, as illustrated schematically in the following representation:



When the ester bond in such units is hydrolyzed, a -CR^7-CR^6-CR^7-CR^6- polymer chain is formed which carries carboxyl groups, for example:



The foregoing further illustrates that the polymers referenced in applicants' claims are distinct from the polymers addressed by the teaching of ***Blankenburg et al.*** because the monomers employed by applicants comprise vinyl esters of C_1-C_{24}-carboxylic acids (a) which form, upon at least partial hydrolysis, (poly)hydroxyl-substituted subsections in the polymer. The monomers employed in accordance with the teaching of ***Blankenburg et al.*** are, in contrast, esters of acrylic acids which form upon at least partial hydrolysis poly(carboxyl)-substituted subsections of the polymer. In light of the foregoing

and for the reasons already presented in applicants' previous reply it is therefore respectfully urged that the teaching of ***Blankenburg et al.*** cannot reasonably be considered to anticipate applicants' invention within the meaning of Section 102(a) and can also not be deemed to render applicants' invention obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is solicited.

Applicants submitted with their earlier reply a terminal disclaimer concerning ***US 6,403,074*** and the Examiner has, accordingly, withdrawn the previous rejection of applicants' Claims 21 to 25 under the judicially created doctrine of obviousness-type double patenting. It is respectfully submitted that the respective terminal disclaimer was submitted in error. To correct that error, applicants have filed a petition to withdraw the terminal disclaimer concerning ***US 6,403,074***. As argued previously and further explained in the foregoing, the subject matter claimed by applicants differs significantly from the subject matter defined in Claims 1 to 6 of ***Blankenburg et al.***'s patent ***US 6,403,074***. It is well settled that the determination of obviousness-type double patenting essentially involves a determination of (un)obviousness under 35 U.S.C. §103, with the exception that the patent disclosure is not applicable as "prior art"[1]. Corresponding to the determination under Section 103, there must be some clear evidence to establish why a person of ordinary skill would made the modification which is necessary to arrive at the claimed invention, and the evidence must be properly qualifiable as "prior art"[2]. Also, in both determinations, the level of skill in the art alone cannot be relied upon to provide the suggestion to modify the prior art[3]. The Examiner's rejection of applicants' Claims 21 to 25 under the judicially created doctrine of obviousness-type double patenting over Claims 1 to 6 of ***US 6,403,074*** was based on the assertion that ***Blankenburg et al.***'s formula reads on applicants' vinyl esters of C_1-C_{24}-carboxylic acids. As explained in the foregoing and argued previously, the Examiner's respective position is not well taken. With-

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1) Cf. In re Braat, 937 F.2d 589, 594, 19 USPQ2d 1289, 1293 (CAFC 1991); In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).

2) Cf. In re Kaplan, 789 F2d 1574, 1580, 229 USPQ 678, 683 (CAFC 1986); Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 337 (CAFC 1985), vacated 475 U.S. 809, 229 USPQ 478 (1986), on remand 810 F.2d 1561, 1 USPQ2d 1593 (CAFC), cert. denied 481 U.S. 1052 (1987).

3) Cf. In re Kaplan, 789 F2d 1574, 1580, 229 USPQ 678, 683 (CAFC 1986).

drawal of the obviousness-type double patenting rejection is therefore respectfully solicited.

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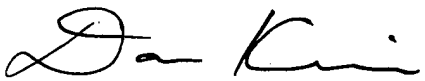
Respectfully submitted,
KEIL & WEINKAUF



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Encl.: Terminal Disclaimer concerning US 6,579,953

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